

## REMARKS

Claims 1-23 and 44-63 are pending in the case. Claims 1-23 were originally filed in the case, claims 24-43 were previously cancelled, and claims 44-63 were previously added. Claims 24-43 were canceled responsive to a restriction requirement. The Office rejected each of claims 1-23 and 44-63 as follows:

- claims 1-5, 7-11, 13-15, 17-22, 44-48, 50-54, 56-58, and 60-63 were rejected as obvious under 35 U.S.C. §103(a) over United States Letters Patent 5,517,414 (“Hrovat”) in view of United States Letters Patent 4,898,257 (“Brandstadter”);
- claims 6, 12, 16, 49, 55, and 59 were rejected as obvious under 35 U.S.C. §103(a) over Hrovat in view of Brandstadter and United States Letters Patent 6,481,801 (“Krueger”); and
- claim 23 was rejected as obvious under 35 U.S.C. §103(a) over Hrovat in view of Brandstadter and United States Letters Patent 5,762,407 (“Stacey et al.”).

Applicant traverses each of the rejections.

### **I. BRANDSTADTER STILL TEACHES AWAY**

Applicant previously argued that these rejections were all fatally flawed by the fact that Brandstadter directly teaches away from using an on-road, active suspension system in an off-road vehicle. More particularly, Applicant points to the passage at col. 2, lines 6-24, which reads:

*In a road vehicle, the dynamic component is primarily due to the acceleration, braking, and cornering inertial forces acting on the vehicle. These forces are smaller than the static force, and the aforescribed parallel arrangement results in a substantial reduction in the energy required to stabilize the vehicle in reaction to these forces.*

*In an off-road vehicle, however, the dynamic component is primarily due to terrain disturbances producing large road wheel motions. The forces associated with these large motions are greater than the static force and the parallel arrangement results in an increase in the energy required to isolate the vehicle in reaction to these motions. Thus, the increased size, weight, and cost of the parallel arrangement is not offset by a comparable reduction in the energy requirements under off-road conditions and, therefore, this*

*type of system is not applicable to off-road vehicles generally and to combat vehicles specifically.*

(emphasis added) Thus, according to Brandstadter, on-road and off-road suspension systems encounter forces differently, and sufficiently differently that on-road suspension systems do not yield sufficient performance for off-road vehicles. Brandstadter therefore specifically teaches away from using on-road active suspension systems in off-road vehicles.

The Office agrees with this construction, but argues that Applicant has taken it out of context:

Applicant argues Brandstadter teaches away from using on-road active suspension systems off-road, citing Brandstadter col 3, line 5-25 [sic]. *While Examiner agrees, the citation has been taken out of context; this text is referring to the shortcoming of prior art US4639013.*

(emphasis added)

Applicant respectfully disagrees. The Office apparently believes the context includes the whole discussion of active suspension systems, which would include the paragraph preceding that which Applicant quoted. It is true the preceding paragraph cites U.S. Letters Patent 4,639,013, but it cites it as an exemplar of the types of systems under discussion:

The *active suspension systems* sense various operating conditions and control both the damping and the spring forces in accordance with the sensed conditions. The *resultant performance of such systems* requires input of considerable energy to drive pump components therein. *U.S. Pat. No. 4,639,013 describes an active suspension apparatus of this type* which attempts to reduce input energy requirements while improving ride. In the '013 patent, a single acting hydraulic actuator and an associated variable, offset, hydropneumatic chamber control the static component of the force acting on the vehicle and a parallel, double acting, hydraulic actuator and an associated servovalve and damping valve control the dynamic component of the force acting on the vehicle.

(col. 1, line 58-col. 2, line 4, emphasis added)

The language “of such systems” clearly indicates a discussion of active suspension systems generally. The phrase “of this type” in the passage “*U.S. Pat. No. 4,639,013 describes an active suspension apparatus of this type*” clearly indicates that the reference is being used as an example of the type of active suspension systems generally under discussion. Thus, contrary

to the Office's assertion, the citation of U.S. Letters Patent 4,639,013 does not limit the teaching to foreclose Applicants construction.

Even in the larger context, the passage of Brandstadter therefore teaches the broader proposition for which Applicant cites it. And Brandstadter therefore teaches away from Hrovat. Accordingly, there can be no motivation or suggestion to combine references as a matter of law where one of the references teaches away from the claimed invention. *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984); M.P.E.P. §2145 X D 2. Thus, under law and under Office policy, Hrovat and Brandstadter are not combinable.

Furthermore, it is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. See, *inter alia*, *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986). It appears the passage quoted above that the Office essentially believes that Applicant has but taken an on-road active suspension system and put it in an off-road vehicle. If this is, indeed, the Office's position, then Brandstadter establishes that Applicant's invention is *prima facie* non-obvious.

## **II. THE OFFICE'S OTHER POSITION IS UNSUPPORTED AND REFUTED BY THE EVIDENCE**

The rest of the Office's position is unsupported and internally contradictory. The Office begins by stating:

Examiner further notes that it is within the ability of one of ordinary skill in the art, and even the ordinary skill of the vehicle driver, to understand the conditions for which a particular suspension arrangement is suitable.

There is no evidence of record to support this proposition. Should this be an assertion fact, then Applicant requests that the Examiner properly support it by placing an affidavit or declaration of personal knowledge in the record or providing other documentary evidence as required by M.P.E.P. §2144.03 C.. Applicant furthermore disputes this assertion because many drivers of on-road vehicles will never attempt to take them off-road. This may be because, for example, (1) they have no desire to do so, or (2) are in fact incapable of determining whether their on-road

suspension can handle certain off-road conditions. Applicant respectfully submits that the assertion is completely without basis in fact.

The Office then begins an extensive discussion of how, despite varying conditions, on-road and off-road suspension systems really are quite the same.

Although the components themselves [of off-road systems] may be adapted differently for particular conditions and applications, the mechanics of the system are often the same, as they are in this case.

The statement that “the mechanics of the system are often the same” necessarily implies the opposite fact, as well—namely, that they often are not. This logic is sweeping aside the very salient fact that in some ways they can be very different. Thus, on-road and off-road are not necessarily as closely related as the Office would like to believe. Notably, this assertion is also unsupported by evidence. Applicant also challenges this assertion, and support must be made of record pursuant to M.P.E.P. §2144.03 C..

The lack of proper support for all of this “reasoning” is all the more critical given the fact that Brandstadter teaches away from the very kind of combination that the Office is attempting to justify. This is even true under the Office’s construction in which Brandstadter is not teaching away from active, on-road suspension systems generally but to that of U.S. Letters Patent 4,639,013. Even under this construction, Brandstadter is directly contradicting the Office’s position that on-road and off-road suspension systems are sufficiently similar to be asserted in this manner. Essentially, Brandstadter refutes the Office’s “parts is parts” approach to applying the cited art and the Office’s position to the contrary is completely devoid of *evidence*. The evidence of record, therefore, refutes the Office’s position.

### III. CONCLUSION

Thus, on its face, Brandstadter refutes the proposition that it can be properly combined with Hrovat. Each of the rejections relies upon the combination of Hrovat and Brandstadter, and so each of the rejections fails since they are not properly combinable. And, if the Office’s position is what it seems, that Applicant’s invention as claimed is *prima facie* unobvious over the art of record. Furthermore, even under the Office’s construction, Brandstadter refutes the

Office's position that the on-road/off-road distinction is irrelevant in examining vehicle suspension systems. Wherefore, Applicant requests that the rejections be withdrawn.

The Examiner is invited to contact the undersigned attorney at (713) 934-4053 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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